

Claim Rejections-35 U.S.C. §112

Claims 71-75 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite "for failing to recite a positive structural limitation." Applicant respectfully traverses this rejection.

In particular, Applicant is not aware of any requirement in the MPEP requiring a dependent apparatus claim to recite a so-called structural limitation. Indeed, the MPEP specifically allows functional language, stating:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.

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A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. (See MPEP §2173.05(g)).

In the present case, Applicant has used functional language in defining the claim 1 invention, and has further limited this functional language in claims 71-75. That is, claim 1 requires that the deployed first and second electrode arrays be configured to necrose a volume of tissue therebetween when electrical energy is applied between the first and second electrode arrays. Claims 71-75 further define the specific volume of tissue that these electrode arrays are configured to necrose, and thus, further limit claim 1.

Thus, Applicant submits that claims 71-75 are definite, and as such, respectfully requests withdrawal of the §112 rejection of these claims.

Claim Rejections-35 U.S.C. §102

Claims 1-14, 16-24, 26-31, 33-44, 46, 47, 49-57, 59-65, 67-70, 76-83, 89-98, 101-108, and 114-117 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,090,105 issued to Zepeda (“Zepeda”). Without acquiescence that Zepeda is, in fact, a §102(e) prior art reference, and without prejudice to antedate this reference should it become necessary, Applicant traverses this rejection, since Zepeda does not disclose each and every element of these claims.

The Examiner has referred to the Fig. 9 embodiment of Zepeda as disclosing every element of these claims. In particular, among other elements, the Examiner has stated that the electrode arrays 16 essentially include electrode ends that face each other. Even assuming that this was true, however, Zepeda still does not disclose each and every element of the claims. In particular, independent claims 1, 16, 33, and 51 all require that the first and second electrode arrays have concave faces that face each other—a feature not found in the Fig. 9 embodiment of Zepeda. For example, Fig. 1 of Applicant’s specification illustrates first and second electrode arrays 12, 14 that have concave faces 22, 26 that face each other. While the distal-most electrode array 16 of the Fig. 9 embodiment has a concave face that faces in the proximal direction, the proximal-most array 16 does not have any concave face that faces in the distal direction.

Thus, Applicant submits that independent claims 1, 16, 33, and 51, as well as the claims depending therefrom (2-14, 17-24, 26-31, 34-44, 46, 47, 49, 50, 52-57, 59-65, 67-70, 76-83, 89-98, 101-108, and 114-117), are not anticipated by Zepeda, and as such, respectfully request withdrawal of the §102 rejection of these claims.

Claim Rejections-35 U.S.C. §103

Claims 7, 15, 25, 32, 45, 48, 48, 58, 66, 71-75, 84-88, 99, 100, and 109-113 stand rejected under 35 U.S.C. §103, as being obvious over Zepeda. Applicant respectfully traverses this rejection, since Zepeda does not disclose, teach, or suggest the combination of elements required by these claims.

In particular, as discussed above, the Fig. 9 embodiment of Zepeda does not have two electrode arrays having concave faces that face each other, as required by independent claims 1, 16, 33, and 51 from which these claims depend. Thus, Applicant believes that claims 7, 15, 25, 32, 45, 48, 48, 58, 66, 71-75, 84-88, 99, 100, and 109-113 are not obvious over Zepeda, and as such, respectfully request withdrawal of the §103 rejection of these claims.

Conclusion

Based on the foregoing, it is believed that all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (949) 724-1849.

Respectfully submitted,

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